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27765	7590	08/20/2008	EXAMINER	
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			PIZIALI, JEFFREY J	
			ART UNIT	PAPER NUMBER
			2629	
			NOTIFICATION DATE	DELIVERY MODE
			08/20/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/709,503	Applicant(s) DENQ ET AL.	
	Examiner JEFF PIZIALI	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2008 and 29 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species II, Sub-Species A (identified by the Applicant as claims 1-4, 6, 7, and 9-18) in the reply filed on 14 April 2008 is acknowledged.

The traversal is on the ground(s): "*Applicants believe that the present application does not need a sub-species election. Species A (defined by claim 7) of the present application discloses the panel layer is a capacitive panel layer. And species B (defined by claim 8) discloses the panel layer is a resistive panel layer. Claims 7 and 8 are amended to depended upon Claim 6. When the panel layer is installed above the plurality of display units [elected Species II], the panel layer can be a capacitive panel layer [elected Sub-Species A] or a resistive panel layer [non-elected Sub-Species B]. The electromagnetic apparatus installed below the plurality of display units and for generating a magnetic field to attract magnetic materials does not influence the operation of the capacitive panel layer or the resistive panel layer. Claims 7 and 8 disclose two kinds of panel layers for the present application. Applicants believe that there is no conflict between claims 7 and 8 based on the reason described above. Therefore, applicants believe that sub-species A and sub-species B of the present application should be grouped together and should not be patentably distinct. Reconsideration of this sub-species restriction requirement is hereby requested"* (see Page 7 of the Election filed 14 April 2008).

This is not found persuasive because the sub-species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such sub-species. In addition, these sub-species are not obvious variants of each other based on the current record.

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There is an examination and search burden for these patentably distinct sub-species due to their mutually exclusive characteristics. The sub-species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one sub-species would not likely be applicable to another sub-species; and/or the sub-species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

It is respectfully noted that the Applicant did not distinctly and specifically point out any supposed errors in the restriction requirement pertaining to Species I and II, the election of at least Species II has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 14 April 2008.

3. This application contains claim 8 drawn to an invention nonelected with traverse in the reply filed on 14 April 2008. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

6. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the figures.

Specification

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-4, 6, 7, and 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

An omitted structural cooperative relationship results from the claimed subject matter: "*a first isolating component installed on a bottom surface of the container and a portion of sidewalls of the container*" (in lines 6-7).

It would be unclear to one having ordinary skill in the art whether one "*first isolating component*" is installed on "*a bottom surface*" and another "*first isolating component*" is installed on "*a portion of sidewalls*"; or rather whether a single "*first isolating component*" is installed on both "*a bottom surface*" and "*a bottom surface*".

Furthermore, it would be unclear to one having ordinary skill in the art whether "*a portion of sidewalls*" is intended to mean a portion of one sidewall; or rather intended to mean a portion of a plurality of sidewalls.

An omitted structural cooperative relationship results from the claimed subject matter: "*neighboring display units*" (in line 8) and "*display units*" (in line 2).

It would be unclear to one having ordinary skill in the art whether the "*neighboring display units*" are intended to be a common subset of the earlier claimed "*display units*"; or

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rather whether the "*neighboring display units*" are intended to be distinct and different from the earlier claimed "*display units*".

An omitted structural cooperative relationship results from the claimed subject matter: "*a touch panel comprising...*" (in line 1); "*each of the display units comprising...*" (in line 2); and "*at least an electromagnetic apparatus*" (as claimed in lines 18-21).

It would be unclear to one having ordinary skill in the art whether the "*touch panel*" is intended to comprise "*at least an electromagnetic apparatus*"; or rather whether the "*each of the display units*" is intended to comprise "*at least an electromagnetic apparatus*".

11. Claim 1 recites the limitation "*sidewalls*" (in line 7). There is insufficient antecedent basis for this limitation in the claim.

12. Claim 1 recites the limitation "*the container*" (in line 10). There is insufficient antecedent basis for this limitation in the claim.

It would be unclear to one having ordinary skill in the art whether this limitation is intended to refer to the earlier claimed "*a container*" (in line 4) or one of the "*containers*" (in line 8).

13. Claim 1 recites the limitation "*the lower chambers*" (in line 13). There is insufficient antecedent basis for this limitation in the claim.

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14. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

An omitted structural cooperative relationship results from the claimed subject matter: "*two electromagnetic apparatuses*" (in claim 11, lines 1-2) and "*at least an electromagnetic apparatus*" (in claim 1, line 18).

It would be unclear to one having ordinary skill in the art whether the "*two electromagnetic apparatuses*" are separate and distinct from the earlier claimed "*at least an electromagnetic apparatus*"; or rather whether at least one of the "*two electromagnetic apparatuses*" are common to and shared with the earlier claimed "*at least an electromagnetic apparatus*".

15. Claim 15 recites the limitation "*the sensor layer*" (in lines 3-4). There is insufficient antecedent basis for this limitation in the claim.

16. The term "*substantially parallel*" in claim 17 (in line 2) is a relative term which renders the claim indefinite. The term "*substantially parallel*" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It would be unclear to one having ordinary skill in the art precisely how close to perpendicular the claimed component must be before it would be considered "*substantially parallel*".

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17. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

An omitted structural cooperative relationship results from the claimed subject matter: *"the first isolating component installed on the bottom surface of the container"* (in claim 17, line 3) and *"a first isolating component installed on a bottom surface of the container and a portion of sidewalls of the container"* (in claim 1, lines 6-7).

It would be unclear to one having ordinary skill in the art whether one *"first isolating component"* is installed on *"a bottom surface"* and another *"first isolating component"* is installed on *"a portion of sidewalls"*; or rather whether a single *"first isolating component"* is installed on both *"a bottom surface"* and *"a bottom surface"*.

18. The remaining claims are rejected under 35 U.S.C. 112, second paragraph, as being dependent upon rejected base claims.

19. Claims 1-4, 6, 7, and 9-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

As a courtesy to the Applicant, the examiner has attempted to also make rejections over prior art -- based on the examiner's best guess interpretations of the invention that the Applicant is intending to claim.

However, the indefinite nature of the claimed subject matter naturally hinders the Office's ability to search and examine the application.

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Any instantly distinguishing features and subject matter that the Applicant considers to be absent from the cited prior art is more than likely a result of the indefinite nature of the claims.

The Applicant is respectfully requested to correct the indefinite nature of the claims, which should going forward result in a more precise search and examination.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-4, 6, 7, and 9-18 are rejected under 35 U.S.C. 102(b) as being anticipated by ***Itkis (US 5,478,084 A)***.

Regarding claim 1, ***Itkis*** discloses a touch panel comprising:

a plurality of display units arrayed in a matrix (see the entire document, including Fig. 1; Column 3, Lines 4-38),

each of the display units comprising:

a container containing magnetic materials [e.g., Fig. 4; 17];

a transparent film [e.g., Figs. 6-7; top 13] installed on an upper surface of the container;

a first isolating component installed on a bottom surface [e.g., Figs. 6-7; bottom 13] of the container and a portion of sidewalls [e.g., Figs. 6-7; vertical portion of 18] of the container

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for isolating the container from containers of neighboring display units and for carrying the magnetic materials; and

a second isolating component [e.g., Figs. 6-7; horizontal portion of 18] for separating the container into an upper chamber [e.g., Figs. 6-7; 19] and a lower chamber [e.g., Figs. 6-7; 20],

the second isolating component having an opening [e.g., Figs. 6-7; 21] between the upper chamber and the lower chambers for allowing the magnetic materials to pass through the opening,

the upper chamber being located between the transparent film and the second isolating component, and

the lower chamber being located beneath the upper chamber and between the second isolating component and the first isolating component installed on the bottom surface of the container (see the entire document, including Column 3, Line 39 - Column 4, Line 35); and

at least an electromagnetic apparatus [e.g., Figs. 6, 7, 13; 9] installed under the plurality of display units to act as a base and used for generating a magnetic field to make the magnetic materials separate from a surface of the second isolating component (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

Regarding claim 2, *Itkis* discloses the first isolating component is composed of insulating materials (see the entire document, including Column 3, Line 39 - Column 4, Line 35).

Regarding claim 3, *Itkis* discloses the second isolating component is composed of insulating materials (see the entire document, including Column 3, Line 39 - Column 4, Line 35).

Regarding claim 4, **Itkis** discloses a panel layer [e.g., Fig. 14; 30] for outputting a corresponding touch signal to a processor [e.g., Fig. 14; 35] when pressed (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

Regarding claim 6, **Itkis** discloses the panel layer is installed above the plurality of display units (see the entire document, including Fig. 13; Column 5, Line 9 - Column 6, Line 20).

Regarding claim 7, **Itkis** discloses the panel layer is a capacitive panel layer (see the entire document, including Column 7, Lines 45-56).

Regarding claim 9, **Itkis** discloses a sensor layer for detecting whether the panel layer is pressed (see the entire document, including Column 7, Lines 45-56).

Regarding claim 10, **Itkis** discloses the electromagnetic apparatus is an electromagnetic field coil (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

Regarding claim 11, **Itkis** discloses two electromagnetic apparatuses [e.g., Fig. 14; 27, 30] installed under the plurality of display units (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

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Regarding claim 12, **Itkis** discloses the magnetic materials in the container are magnetic powder (see the entire document, including Column 3, Line 39 - Column 4, Line 35).

Regarding claim 13, **Itkis** discloses the transparent film of each of the display units is composed of insulating materials (see the entire document, including Column 3, Line 39 - Column 4, Line 35).

Regarding claim 14, **Itkis** discloses an electromagnetic apparatus switch to switch the electromagnetic apparatus on and off (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

Regarding claim 15, **Itkis** discloses a contact layer installed between the plurality of display units and the panel layer, for transferring stress from the plurality of display units to the panel layer and the sensor layer (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

Regarding claim 16, **Itkis** discloses the contact layer comprises a plurality of protruding materials (see the entire document, including Column 7, Lines 45-56).

Regarding claim 17, **Itkis** discloses the second isolating component is horizontal and substantially parallel to the transparent film and the first isolating component installed on the bottom surface of the container (see the entire document, including Figs. 6-7).

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Regarding claim 18, *Itkis* discloses the touch panel is installed on a portable computer (see the entire document, including Column 5, Line 9 - Column 6, Line 20).

Response to Arguments

22. Applicant's arguments filed 29 September 2007 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-4, 6, 7, and 9-18 have been considered but are moot in view of the new ground(s) of rejection.

By such reasoning, rejection of the claims is deemed necessary, proper, and thereby maintained at this time.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFF PIZIALI whose telephone number is (571)272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/

Primary Examiner, Art Unit 2629

15 August 2008